

REMARKS

Applicant thanks the Examiner for the attention accorded the present Application in the March 20, 2007, Office Action. Claims 1-40 are pending in this application. Reconsideration in view of the following remarks is respectfully requested.

Claim Rejections

In that Action, Claims 13-21 are objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 1, 4, 5, 11, 12, 16, 22, 31-33 and 36-40 are rejected under 35 U.S.C. 102 (e) as being anticipated by Kessler et al. (US 7,170,999). Corrections for claims 13-21 have been made in this response.

Claims 2, 3, 6-10, 13-15, 17-21, 34 and 35 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Kessler et al. (US 7,170,999), in view of Pensake et al. (US Pub NO. 2001/0052074). Claim 23 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Kessler et al. (US 7,170,999), in view of Andivahiset et al. (US 7,146,009). Claims 24-30 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Kessler et al. (US 7,170,999), in view of Andivahiset et al. (US 7,146,009), further in view of Pensake et al. (US Pub NO. 2001/0052074).

Applicant does not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the claims in a subsequent patent application that claims priority to the instant application.

Claim Amendments

To overcome the rejections, claim 1 has been amended to include the subject matter of claims 4-5, while claim 12 has been amended to include the subject matter of claims 15-16. Claims 4-5, 15-16, and 23-40 have been cancelled. No new matter is therefore entered.

35 U.S.C. §102(e) rejections based on Kessler

The Examiner rejects claims 1 and 12 under 35 U.S.C. 102 (e) as being anticipated by Kessler et al. Applicant traverses this rejection.

In the amended claim 1 of this invention, the information processing software of the author computer comprising **a plurality of universal keys with encoded serial number**, and the encrypting process of the content key is first executed by the step of **choosing one of the plurality of universal keys** and encrypting the content key by the chosen universal key.

Kessler does disclose a content key encrypted by a public key. Instead, in Kessler, **the public key is sent from the client computer to the author computer** through the application server. Alternatively, **the client computer sends the public key to the author computer** (Col. 9, Lines 35-40). In other words, the public key is not chosen from **a plurality of universal keys with encoded serial number from the author computer**.

In comparison, according to Applicant's invention, the encrypting process of the content key also executes the step of **storing the encrypted content key and the serial number of the universal key to a header** and adding the header in front of the encrypted digital information. However, Kessler discloses that only the **encrypted content key** is stored in a header portion of a secured file (Col. 10, Lines 8-17). Applicant does not believe that the remaining secondary references to Pensake et al. and Andivahiset et al. supply this deficiency.

Accordingly, Applicant submits that Kessler does not render claim 1 obvious. Applicant submits that claim 1 is patentable and respectfully requests withdrawal of the rejection of claim 1.

Similarly, the information processing software of the author computer in the amended claim 12 of this invention comprises **a plurality of universal keys with encoded serial number**. The arguments set forth in the above regarding to claim 1 also apply to claim 12. Applicant submits that Kessler also does not render claim 12 obvious.

Applicant notes that Pensake et al. has not been cited against canceled claims 4-5 (now incorporated into claim 1 by amendment) or canceled claim 16 (now incorporated into claim 12 by amendment). In addition, Applicant notes that

Andivahiset et al. has not been cited against canceled claims 4-5 (now incorporated into claim 1 by amendment) or canceled claims 15-16 (now incorporated into claim 12 by amendment). As a result, Applicant believes that a detailed discussion of these secondary references is not warranted. However, supererogatorily, Applicant does not believe that either Pensake et al. or Andivahiset et al. supply the above noted deficiencies of the primary reference to Kessler.

Accordingly, even if the teachings of Kessler, Pensake et al., and Andivahiset et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: a digital information protecting method for encrypting a piece of digital information from an author computer with assistances from a server, and then transmitting an encrypted digital information to a client computer via a computer network for the client computer to decrypt the encrypted digital information to be used, both the author computer and the client computer comprising a predetermined information processing software to process the piece of digital information, the information processing software of the author computer comprising a plurality of universal keys with encoded serial number, the method comprising: in the author computer: receiving a content key from a server and encrypting the piece of digital information by the content key; choosing one of the plurality of universal keys, and encrypting the content key by the chosen universal key; storing the encrypted content key and the serial number of the universal key to a header, and adding the header in front of the encrypted digital information; and transmitting the encrypted digital information and the encrypted content key to the client computer; and in the client computer: decrypting the encrypted content key by a corresponding predetermined key decrypting process; and decrypting the encrypted digital information by the content key to make the piece of digital information can be used by the client computer.

Nor does the combination suggest: a digital information protecting system for encrypting a piece of digital information from an author computer with assistances from a server, and then transmitting an encrypted digital information to a client computer via a computer network for the client computer to decrypt the encrypted digital information to be used, both the author computer and the client computer comprising a predetermined information processing software to process the piece

of digital information, the system comprising: a first digital information process software, being set in the author computer, the information processing software of the author computer comprising a plurality of universal keys with encoded serial number, the first digital information process software comprising: a content encrypting module, for receiving a content key from a server; and encrypting the piece of digital information by the content key; and a key encrypting module, for choosing one of the plurality of universal keys, and encrypting the content key by the chosen universal key; storing the encrypted content key and the serial number of the universal key to a header, and adding the header in front of the encrypted digital information; and transmitting the encrypted digital information and the encrypted content key to the client computer; and a second information process software, setting in the client computer, comprising: a key decrypting module, for decrypting the encrypted content key by a corresponding predetermined decrypting process; and a content decrypting module, for decrypting the encrypted digital information by the content key to make the piece of digital information can be used by the client computer.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an

alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Kessler, Pensake et al., or Andivahiset et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Kessler, Pensake et al., nor Andivahiset et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed system or method. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.

Applicant also submits that the dependent claims 2-11 and 13-22 not specifically addressed herein are allowable for the reasons discussed in pertinent portions associated with their independent claims 1 and 12, as well as for their own additional features. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Reconsideration of claims 1-18 is respectfully requested.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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